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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,464	07/29/2003	Jon Elliot Adler	67824.426001	4703
21967 7590 07/29/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER HOWARD, ZACHARY C	
			ART UNIT 1646	PAPER NUMBER
			MAIL DATE 07/29/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/628,464

Applicant(s)

ADLER ET AL.

Examiner

ZACHARY C. HOWARD

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 118-123 and 128-141 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 118-120, 122, 123 and 128-140 is/are rejected.
- 7) ☒ Claim(s) 121 and 141 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application, Amendments and/or Claims

The amendment of 5/5/08 has been entered in full. Claims 118, 120, 128 and 129 are amended.

Claims 118-123 and 128-141 are pending in the instant application.

Inventorship

In view of the papers filed 5/5/2008, the inventorship in this nonprovisional application has been changed. Specifically, the petition under 37 CFR § 1.48(b) filed on 5/5/2008 to delete Mark Zoller, an originally named inventor in the instant application, has been reviewed and is granted.

Withdrawn Objections and/or Rejections

The following page numbers refer to the previous Office Action (1/8/08).

The objections to claims 118 and 120 at pg 2 for informalities are *withdrawn* in view of Applicants' amendments to the claims.

The rejection of claims 128 and 129 under 35 U.S.C § 112, second paragraph, at pg 8 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is *withdrawn* in view of Applicants' amendments to the claims.

Maintained Objections and/or Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 118-120, 122, 123, 128, 129 and 133-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO200257309 (Miwa et al, 7/25/02; cited previously) and further in view of U.S. Patent 5,763,218 (Fujii et al, 6/9/98; cited previously). This rejection was set forth at pg 3-5 of the 1/8/08 rejection.

Applicants' arguments (5/5/08; pg 8) as they pertain to the rejection have been fully considered but are not deemed to be persuasive for the following reasons.

In the response, Applicants argue that they have filed a Petition to delete "Mark Zoller as a co-inventor based on the fact that he did not make an inventive contribution to any of the current claims" and request withdrawal of the rejection.

Applicants' arguments have been fully considered and are found to be persuasive in part, but the rejection is maintained for the following reasons. The 1/8/08 Office Action set forth two reasons that the 1.131 Affidavits submitted by Applicants on 9/3/05 and 12/6/06 are not sufficient to overcome a rejection based on Miwa's 102(a) date (such as the instant 103(a) rejection set forth above). These two reasons were (1) the signed Declarations submitted on 9/3/05 and 12/6/06 do not produce documentary evidence and exhibits showing conception and completion of invention in this country or in a NAFTA or WTO member country and (2) the signed Declarations submitted on 9/3/05 and 12/6/06 are signed by less than all of the inventors of the claimed subject matter. Applicants' deletion of Mark Zoller as an inventor has removed reason #2 as a basis for maintaining the rejection. However, Applicants response does not address reason #1, and therefore the rejection is maintained.

As set forth previously, one requirement of a declaration under 37 CFR 1.131 is that "[p]rior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country." MPEP 715.07.III states, "The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the

conception being at a date prior to the effective date of the reference." The signed Declarations submitted on 9/3/05 and 12/6/06 and do not meet these requirements, because they do not produce documentary evidence and exhibits showing conception and completion of invention in this country or in a NAFTA or WTO member country.

Therefore, it is maintained that the 1.131 Affidavits submitted by Applicants on 9/3/05 and 12/6/06 are not sufficient to overcome a rejection based on Miwa's 102(a) date (such as the instant 103(a) rejection set forth above).

Claims 130-132, 139 and 140 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO200257309-A1 (Miwa et al, published July 25, 2002; cited previously) and further in view of U.S. Patent 5,763,218 (Fujii et al, published June 9, 1998; cited previously) and in further view of U.S. Patent 6,004,808 (Negulescu et al, published 12/21/1999; cited previously). This rejection was set forth at pg 5-6 of the 1/8/08 rejection.

Applicants' arguments (5/5/08; pg 9) as they pertain to the rejection have been fully considered but are not deemed to be persuasive for the following reasons.

In the response, Applicants argue that they have filed a Petition to delete "Mark Zoller as a co-inventor based on the fact that he did not make an inventive contribution to any of the current claims" and request withdrawal of the rejection.

Applicants' arguments have been fully considered and are found to be persuasive in part, but the rejection is maintained for the following reasons. The 1/8/08 Office Action set forth two reasons that the 1.131 Affidavits submitted by Applicants on 9/3/05 and 12/6/06 are not sufficient to overcome a rejection based on Miwa's 102(a) date (such as the instant 103(a) rejection set forth above). These two reasons were (1) the signed Declarations submitted on 9/3/05 and 12/6/06 do not produce documentary evidence and exhibits showing conception and completion of invention in this country or in a NAFTA or WTO member country and (2) the signed Declarations submitted on 9/3/05 and 12/6/06 are signed by less than all of the inventors of the claimed subject matter. Applicants' deletion of Mark Zoller as an inventor has removed reason #2 as a

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basis for maintaining the rejection. However, Applicants response does not address reason #1, and therefore the rejection is maintained.

As set forth previously, one requirement of a declaration under 37 CFR 1.131 is that "[p]rior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country." MPEP 715.07.III states, "The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference." The signed Declarations submitted on 9/3/05 and 12/6/06 and do not meet these requirements, because they do not produce documentary evidence and exhibits showing conception and completion of invention in this country or in a NAFTA or WTO member country.

Therefore, it is maintained that the 1.131 Affidavits submitted by Applicants on 9/3/05 and 12/6/06 are not sufficient to overcome a rejection based on Miwa's 102(a) date (such as the instant 103(a) rejection set forth above).

Objections

Claims 121 and 141 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary C. Howard whose telephone number is 571-272-2877. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary B. Nickol can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Z. C. H./

Examiner, Art Unit 1646

/Elizabeth C. Kemmerer/
Primary Examiner, Art Unit 1646